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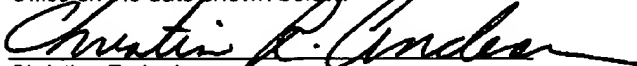
FORMAL SUBMISSION OF:

- 1) Reply Brief.

Title: METHOD AND APPARATUS FOR DETERMINING THE CARRIER USE FOR
AN AIN CALL
Serial No. 09/654,444
Filing Date: September 1, 2000
First Named Inventor: Stephen Paul BRENNAN
Atty. No. 00-5008

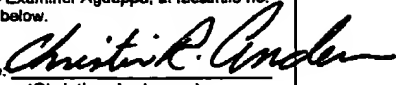
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Dated: February 1, 2005 Signature: 

(Christian Andersen)

Docket No.: 00-5008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Stephen Paul Brennan et al.

Group Art Unit: 2642

Serial No.: 09/654,444

Examiner: Hector A. Agdeppa

Filed: September 1, 2000

For: **METHOD AND APPARATUS FOR DETERMINING
THE CARRIER USED FOR AN AIN CALL**

Attorney Docket No.: 00-5008

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Reply Brief submitted pursuant to 37 C.F.R. § 1.193 in response to the Examiner's Answer mailed December 1, 2004 ("Examiner's Answer"). Appellants' Appeal Brief ("Appeal Brief") was filed on January 27, 2003.

Claims 1-24 are pending. In the Final Office Action mailed July 30, 2002 ("Final Office Action"), claims 1-24 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. 6,205,214 ("Culli"). Claims 1-24 were originally the subject of this Appeal. The Examiner's Answer allowed claims 11 and 24. Accordingly, claims 1-10 and 12-23 remain the subject of this Appeal, and are addressed in this Reply Brief.

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ARGUMENT**A. Independent Claims 1, 12, And 22 Are Patentable Over Culli.**

Independent claim 1 specifically requires certain steps to be performed “in the order given” including “determining whether a called party is inside a local calling scope of a calling party” and *then*

responsive to a determination that said called party is outside said local calling scope of said calling party, selecting a second carrier as said carrier type if an originating LATA of said calling party and a terminating LATA of said called party are the same and selecting a third carrier as said carrier type if said originating LATA and said terminating LATA are different.

Independent claim 12 similarly requires “means for determining whether a called party is inside a local calling scope of a calling party” as well as “means, responsive to operation of said determining means . . . , for selecting a second carrier . . . and a third carrier . . .” Further, independent claim 22 requires “first instructions for determining whether a called party is inside a local calling scope of a calling party” and “third instructions, responsive to said first instructions . . . for selecting a second carrier . . . and a third carrier . . .” Culli clearly does not teach or suggest these claim limitations, particularly in the order required by each of the claims. (See Appeal Brief at 4-5.)

1. Culli Fails To Teach Or Suggest Several Elements Of Appellants’ Claims.

The Examiner’s Answer (page 9) asserts that Culli teaches the above-quoted claim limitations simply because Culli discloses that her system is not limited to “any type of network traffic.” However, even if Culli “contemplates usage in local traffic” (Examiner’s Answer, page 10), this does not mean that Culli teaches or suggests the limitations of Appellants’ claims. At a minimum, nowhere does Culli teach or suggest the recited selection of a second carrier and a third carrier. The Examiner’s Answer (page 10) presents a diagram that purports to show how Culli reads on claim 1. However, the Examiner provides absolutely no support in Culli for the recited selection of a second carrier and a third carrier based on LATAs.

2. Culli Fails To Teach Or Suggest The Required Order Of Appellants’ Claims.

In maintaining that “there is no criticality of the claimed order either in the claims or the specification” (Examiner’s Answer, page 11), the Examiner simply ignores the plain language of claims 1, 12, and 22 that explicitly recites the required

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order of their steps. (*See* Appeal Brief, page 6.) For example, the Examiner ignores the fact that, in claim 1, each subsequent recited step depends on its preceding step. Similarly, a plain reading of the limitations of claims 12 and 22, quoted above, demonstrates the dependence of the final limitation of the claims on preceding limitations. The fact that this required order is not found in the prior art is, by itself, sufficient to prevent denial of patentability of Appellants' claims.

3. Culli Actually Teaches Away From Appellants' Claims.

As noted in the Appeal Brief (pages 5-6), Culli actually teaches away from the invention of claim 1. Culli discloses using LATAs to determine if a call is local, and then routing a call. Claim 1, in contrast, requires determining if a call is local, and *then* comparing LATAs in order to select a carrier. Thus, not only does Culli fail to teach or suggest the recited selection of carriers, but Culli teaches routing calls in an entirely different way than is required by claims 1, 12, and 22.

4. The Prior Art Lacks Motivation For A Modification Of Culli That Meets All Elements of Claims 1, 12, And 22.

The Examiner's argument (Examiner's Answer, page 11) that one of ordinary skill in the art could have chosen either the method of Culli or the method of claim 1 begs the fact that Culli does not, as noted above, teach or suggest the method of claim 1. Indeed, the Examiner appears to be admitting that Culli and claim 1 contain mutually exclusive teachings. Moreover, even if Culli were capable of being modified to practice claim 1, which it is not, the Examiner advances a new argument regarding the motivation of one of ordinary skill in the art to create such a combination. Not only is the argument that motivation to modify Culli is provided by a desire to avoid "additional processing power and processing time" a new argument, but neither does the Examiner provide any citation to the prior art of record in support of this alleged motivation. Accordingly, claim 1 is patentable, at least because the Examiner has not made up for Culli's acknowledged deficiencies.

For at least the foregoing reasons, claim 1, and also independent claims 12 and 22, are in condition for allowance, and a reversal of the rejections thereof is accordingly respectfully requested. Claims 2-10, 13-21, and 23 are in condition for allowance at least by reason of their dependence on the foregoing. Moreover, as discussed below, a number of these claims include independently patentable subject matter.

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B. Claims 2-6, 13-17, And 23 Are Patentable Over Culli.

Claim 2 requires determining originating and terminating rate centers. The Examiner argues (Examiner's Answer, page 13) that differing rates for different kinds of calls are known, and therefore the limitations of claim 2 are inherent in Culli. However, inherency requires that the cited prior art *could not function without the allegedly inherent element*. See MPEP § 2112(IV). Here, there is no dispute that Culli could function without originating and terminating rate centers. For example, the Examiner did not dispute Appellants' argument in the Appeal Brief that a "telecommunications network could be built having, for example, a single global rate center or no rate center." (Appeal Brief, page 8). Accordingly, Culli simply does not disclose the recited limitations of claim 2.

Moreover, the Examiner's Answer (page 13) implicitly concedes that Culli does not inherently disclose the limitations of claim 2. Indeed, the Examiner advances a new argument regarding the motivation of one of ordinary skill in the art to have modified Culli to meet the limitations of claim 2. The Examiner states that "it is old and well known in the art that terminating rate centers and originating rate centers are usually, if not exclusively, implemented." (Examiner's Answer, page 13) However, not only is this argument new, but the Examiner provides no support for this statement in the prior art of record. Accordingly, an obviousness rejection of claim 2 over Culli cannot stand.

For at least the foregoing reasons, claim 2 is in condition for allowance and a reversal of the rejection thereof is respectfully requested, along with a reversal of the rejections of the other claims in the same claim group as claim 2.

C. Claims 7 And 18 Are Patentable Over Culli.

As noted in the Appeal Brief (page 9), claim 7 is patentable because not only does Culli not teach or suggest rate centers, but Culli certainly does not teach or suggest any determination that a called party is within a local calling scope based on "when said terminating rate center is found in an originating rate center table for said originating rate center." Indeed, the Examiner completely fails to address this claim limitation. For at least the foregoing reasons, claim 7, and also claim 18, which includes these limitations, are in condition for allowance, and a reversal of the rejections of claims 7 and 18 is respectfully requested.

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D. Claims 8 and 19 are Patentable Over Culli

Appellants do not concede that Culli's disclosure of "customized calling plans" reads on the recited "extended dial plan" of claim 8. However, even if it did, it would be impossible for Culli to read on claim 8, because Culli does not disclose or suggest a terminating rate center, an originating rate center table, or an originating rate center. (See Appeal Brief, page 9). For at least this reason, claim 8, and also claim 19, which includes these limitations, are in condition for allowance, and a reversal of the rejections of claims 8 and 19 is respectfully requested.

CONCLUSION

In view of the foregoing arguments, a reversal of the rejections of record is respectfully requested of this Honorable Board. It is believed that no fee is due with this Reply Brief. However, please charge our Deposit Account No. 07-2347, under Order No. 00-5008, from which the undersigned is authorized to draw, for any fee due with this Reply Brief.

Dated: February 1, 2005

Respectfully submitted,

By 

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